



UNITED STATES PATENT AND TRADEMARK OFFICE

29 MAY 2003

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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EMPK & SHILOH, LLP
116 JOHN ST., SUITE 1201
NEW YORK, NY 10038

In re Application of SHEMI et al.
Application No.: 10/590,053
PCT No.: PCT/IL05/00208
Int. Filing: 20 February 2005
Priority Date: 04 February 2004
Attorney Docket No.: P-6624-US
For: SYSTEM AND METHOD FOR THE
FABRICATION OF AN ELECTRO-OPTICAL
MODULE

: DECISION ON RENEWED
: PETITION UNDER
: 37 CFR §§1.47(a) and 1.137(b)

This is a decision on applicant's renewed petition under 37 CFR §§1.137(b) and 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 02 April 2008, to accept the application without the signature of joint inventor Dr. Amotz Shemi.

BACKGROUND

On 20 November 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required. The application went abandoned on 20 June 2007 for failure to reply to the 20 November 2006 Notification of Missing Requirements within the time period set therein. A Notification of Abandonment was not mailed to applicant.

On 20 December 2007, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor Shemi and a revocation of power of attorney with new appointment. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signature of inventor Shemi, alleging that Dr. Shemi refused to sign the application.

On 21 February 2008, a decision dismissing the petition was mailed to applicant indicating, *inter alia*, that with regard to the petition to revive, the proper reply had not been furnished and with regard to the petition under 37 CFR 1.47(a), petitioner had not demonstrated the non-signing inventor's refusal to sign the application.

On 02 April 2008, Petitioner filed the instant renewed petition along with a newly executed declaration and first-hand statements of fact regarding the non-signing inventor's refusal and the circumstances of the delay in filing the petition to revive.

DISCUSSION

Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee required by law for revival of an unintentionally abandoned application (1.17(m)), and (3) a statement that the "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional".

With regard to Item (1), a review of the application file reveals that the proper reply, a declaration executed by the inventors, in compliance with 37 CFR 1.497(a) and (b), has now been provided.

Item (2) was previously satisfied.

With respect to Item (3), statements by Yosi Barkai, former counsel of record at the time the Notification of Missing Requirements issued (20 November 2006) until approximately 15 May 2007 and of the Shai Belzer, Chief Financial Officer of ColorChip, Ltd. were provided and indicate that the entire delay was unintentional. Thus, Petitioner has met all of the requirements of 37 CFR 1.137(b) and the petition is granted.

Petition under 37 CFR 1.47(a)

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1) and (3) were previously satisfied.

With regard to item (4), Petitioner has provided a newly executed declaration, which is in compliance with 37 CFR 1.497(a) and (b) and is acceptable as filed. Item (4) is now satisfied.

With respect to Item (2) above, the declaration by Shai Belzer, Chief Financial Officer of ColorChip, Ltd. was attached to the petition, detailing the efforts made to obtain the nonsigning inventor's signature. According to his declaration, on 18 March 2008, Mr. Belzer sent, via Courier Service of the Israeli Post Office, a package containing a complete copy of the application including specification, drawings, claims, preliminary amendment and a declaration to Dr. Shemi's last known address. Two attempts to deliver the package were unsuccessful and Dr. Shemi did not respond to the notices to arrange delivery. On 25 March 2008, Mr. Belzer "spoke to Dr. Shemi by telephone and requested that he cooperate and sign the Inventor Declaration. He explicitly refused and told me to stop bothering him, as he will not sign any documents." This is sufficient evidence of the non-signing inventor's refusal to sign the application papers.

In sum, Petitioner has satisfied Items (1) - (4). Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

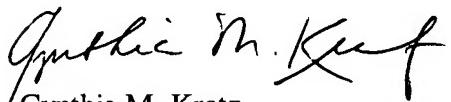
CONCLUSION

The petitions under 37 CFR §§1.47(a) and 1.137(b) are **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR

1.47(a) application using the declaration filed 02 April 2008. The application has an international filing date of 20 February 2005 under 35 U.S.C. 363, and a date of 2 April 2008 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.



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: 37 CFR §§1.47(a)

Dear Dr. Shemi:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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